

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed February 28, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 103(a)**

Claims 1-23, 25, 26, 28, 29, 31, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nishikawa* (U.S. Pat. No. 6,486,968) in view of *Inoue* (U.S. Pat. No. 4,714,940). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations. Applicant discusses the references and Applicant's claims in the following.

#### A. The Nishikawa Disclosure

Nishikawa discloses an output control method and apparatus. *Nishikawa*, Patent Title. As described by Nishikawa, the apparatus includes a host computer 3000 and a printer 1500. *Nishikawa*, column 4, lines 52-57; column 5, lines 14-19. The host computer is used to monitor the status of the printer, and to provide a visual indication of the printer on the host computer's display. *See Nishikawa*, column 6, lines 7-49.

Nishikawa describes the process used to effect this result in detail in columns 5 and 6. As is described by Nishikawa, prior to sending a print job to the printer, the host computer sends a command for setting the printer to report a status when the state in the printer changes. *Nishikawa*, column 5, lines 56-58. Upon receiving the command, the printer starts the transmission of the status to the host computer. *Nishikawa*, column 5, lines 64-67. Upon receiving the transmission from the printer, the host computer knows the printer status prior to printing. *Nishikawa*, column 6, lines 4-5. Next, the host computer transmits print data to the printer. *Nishikawa*, column 6, lines 35-36. When the print data is received, and the status of the printer therefore changes, the printer returns the status change information to the host computer. *Nishikawa*, column 5, lines 32-34. The content of the received status is transferred to an animation control

program of the host computer that controls display of the printer status on the host computer screen. Nishikawa, column 6, lines 46-49.

Notably, Nishikawa is silent as to selecting graphics for display on Nishikawa's printer.

### **B. The Inoue Disclosure**

Inoue discloses an image processing apparatus that can simultaneously or selectively copy an image displayed on a display screen and an image on an original at an arbitrary location. *Inoue*, column 6, lines 12-17. In addition, Inoue discloses "display means for displaying an image in response to an information signal from the data inputting means and image processing means which can copy an image of this display means are integrally constituted as a system". *Inoue*, column 7, lines 34.40.

### **C. Discussion of Applicant's Claims**

#### **1. Claims 1-8, 22, and 23**

Applicant's claim 1 provides as follows (emphasis added):

1. (Currently amended) A method for facilitating display of a graphic on an electrical device, comprising:

*receiving from a user with a host computer a selection of graphical data representing a graphic to be transmitted to an electrical device that is one of a printer, a photocopier, a facsimile machine, a multifunction peripheral, and a network appliance; and*

*facilitating transmission of the graphical data representing the graphic from the host computer to the electrical device such that the electrical device can display the graphic in a control panel display of the electrical device.*

As is described above, Nishikawa describes a system in which a status of a printer is conveyed to a host computer for the purpose of showing an animation that indicates the printer's status on the host computer display. Given that fact, it is clear that Nishikawa does not even teach a "method for facilitating display of a graphic on an electrical device" that is one of "a printer, a photocopier, a facsimile machine, a multifunction peripheral, and a network appliance". Therefore, it is difficult to understand why the Examiner believes that the Nishikawa reference is even relevant to Applicant's claims.

Regardless, turning to the various limitations of claim 1, Nishikawa does not teach or suggest "*receiving from a user* with a host computer *a selection of graphical data* representing a graphic to be transmitted". Specifically, Nishikawa simply does not discuss a user "selecting" any graphical data.

Nishikawa further does not teach or suggest "facilitating transmission of the graphical data . . . from the host computer to the electrical device such that the electrical device can display the graphic in a control panel display of the electrical device". First, Nishikawa does not even mention transmitting graphical data from a host computer to an electrical device, wherein the electrical device is one of a printer, a photocopier, a facsimile machine, a multifunction peripheral, and a network appliance. Instead, as described above, Nishikawa teaches transmitting "status change information" from a printer to a host computer. Therefore, not only does Nishikawa fail to teach sending graphics *from* a host computer *to* a printer, Nishikawa fails to even teach sending graphical data in the first place. As described above, Nishikawa's printer only sends status change information that is used by the host computer's "animation control program" that decides which graphic to show the user. Second,

Nishikawa does not teach or suggest display of any graphic “in a control panel display of the electrical device”. Again, Nishikawa only describes display of graphics on a monitor of the host computer.

Turning to the Inoue disclosure, Applicant notes that, despite Inoue’s general teaching that graphics are sometimes displayed on printers, Inoue provides no suggestion or motivation to a person having ordinary skill to modify Nishikawa’s system to: (i) receive from a user a selection of graphical data, (ii) transmit the user-selected graphical data from one device to another, or (iii) to specifically transmit the graphical data from a host computer to a printer. In other words, Nishikawa’s mere teaching of sending status change information from a printer to a host computer, and Inoue’s teaching of displaying graphics on a printer do not provide any suggestion or motivation to a person having ordinary skill in the art to send a graphic from a host computer for display on a printer.

Given the lack of a suggestion or motivation contained in the prior art for the proposed modification, it appears clear that the only suggestion or motivation comes from Applicant’s own disclosure. As is well established in the law, such hindsight to the Applicant’s own disclosure is *per se* improper. See *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

In view of the above, Applicant submits that the Nishikawa/Inoue combination clearly fails to render claims 1-8 and 22-23 obvious.

## **2. Claims 9-21, 25, 26, 28, 29, 31, and 32**

Nishikawa and Inoue are similarly deficient in rendering obvious independent claims 9, 14, and 19, as described in the following.

Beginning with independent claim 9, Nishikawa and Inoue do not teach or suggest “means for receiving from a user a selection of graphical data” or “means for facilitating transmission of the graphical data representing the graphic to the electrical device such that the electrical device can display the graphic in a control panel display of the electrical device” wherein the electrical device is one of a printer, a photocopier, a facsimile machine, a multifunction peripheral, and a network appliance, for reasons similar to those discussed above in relation to claim 1. Accordingly, claims 9-13 and 25-26 are allowable over Nishikawa.

Regarding independent claim 14, Nishikawa and Inoue fail to teach or suggest “receiving with an electrical device that is one of a printer, photocopier, a facsimile machine, a multifunction peripheral, and a network appliance graphical data sent to the electrical device from a host computer” or that the graphical data had been “selected by a user with the host computer”, for reasons described in the foregoing. In view of these reasons, Nishikawa and Inoue do not render obvious any of claims 14-18 and 28-29. Furthermore, Nishikawa and Inoue do not teach or suggest “receiving with the electrical device an indication from the host computer as to how a graphic represented by the selected graphical data is to be displayed in a control panel display of the electrical device” or “displaying the graphic in the electrical device control panel display according to the received indication as to how the graphic is to be displayed”, also for reasons described in the foregoing. In view of these reasons, Nishikawa and Inoue do not render obvious any of claims 14-18 and 28-29.

Turning to independent claim 19, neither Nishikawa nor Inoue teach or suggest “means provided on an electrical device that is one of a printer, a photocopier, a facsimile machine, a multifunction peripheral, and a network appliance for receiving graphical data that has been selected by the user from a computing device”, “means

provided on the electrical device for receiving an indication as to how a graphic represented by the selected data is to be displayed”, or “means provided on the electrical device for displaying the graphic in a control panel display of the electrical device according to the received indication as to how the graphic is to be displayed”, for reasons described above. Therefore, claims 19-21 and 31-32 are allowable over the Nishikawa/Inoue combination.

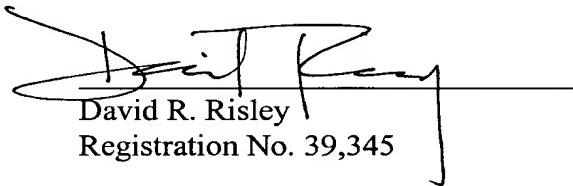
## **II. New Claims**

Claims 34-37 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

## CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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David R. Risley  
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

May 8, 2006  
Stephanie Riley  
Signature